

REMARKS**Overview**

Claims 1-7, 9-10, 12-14 and 21 were previously pending in this application. Claims 1-7, 9-10, 12-14 and 21 were rejected. Independent claims 1 and 21 have been cancelled and rewritten as new claims 22 and 23 respectively. The term "skills" has been changed to "competencies" to put the claims more in-line with the Specification. Dependent claims 2-5 and 7 are currently cancelled. Dependent claims 6, 9, and 12 are currently amended. The remaining claims 13 and 14 are in original form.

This response is an earnest attempt to put all the claims in this application in form for immediate allowability. Favorable reconsideration is respectfully requested.

Claim Rejections Under 35 U.S.C. Section 112

Claim 1 was rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out distinctly claim the subject matter which Applicant regards as the invention. Examiner noted that claim 1 recited the limitation of "the specific job", lacks sufficient antecedent basis. Claim 1 has been cancelled and rewritten as new claim 22 and the preamble now reads, among other things "a specific job comprising", rather than "a specific job *position* comprising". Therefore, new claim 22 provides adequate antecedent basis for the limitation "the specific job". New claim 22 overcomes the 35 U.S.C. § 112, paragraph two rejection of original claim 1. Therefore, allowance of new claim 22 is respectfully requested.

Claims 6, 9, 10, and 12-14 depended from independent claim 1 and were therefore rejected under the same rationale of 35 U.S.C. § 112. However, claim 1 has been rewritten as new claim 22 to overcome this rejection. Therefore, allowance of the claims depending from claim 22 is respectfully requested.

Claim Rejections Under 35 U.S.C. § 103

Claims 1-7, 9-10, 12-14 and 21 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Taub U.S. Patent No. 6,341,267 in view of Barney U.S. Patent No. 6,070,143.

Claims 1 and 21 have been rewritten as new claims 22 and 23 respectively to require, among other things, "providing a set of proposed interview questions related to the set of defined job characteristics to assist hiring authorities to plan structured selection interviews." While this limitation is similar to original claim 7, it is not found individually or in combination in any of the sections of the two references cited by the Examiner. The remaining sections of new claims 22 and 23 are changes for clarity sake and are not intended to be limiting in any way. Support for the amendments is found in the Specification and Figures; therefore, no new matter has been added.

Independent claims 22 and 23 are directed to analyzing potential job performance, as opposed to analyzing behavioral characteristics as the prior art does. In addition, claims 22 and 23 provide potential employers with information about job applicants or existing employees and their competency sets.

As evidence of a key difference between claims 22 and 23 and the cited references, Applicant's step (e) provides proposed interview questions to ensure higher success rate of selection of employees. It is submitted that no methodology in the cited references either alone or in combination disclose or teach a step of providing a set of proposed interview questions related to the set of defined job characteristics.

In addition, it is respectfully submitted that the Examiner has not made out a *prima facie* case of obviousness under 35 U.S.C. § 103 and that Applicant's pending claims are allowable. In order to sustain a *prima facie* case of obviousness, the cited references must have a) some

suggestion or motivation to modify or combine the reference teachings, b) a reasonable expectation of success and c) must teach or suggest all of the claim limitations. See MPEP § 706.02(J). The Examiner has not fulfilled his obligation of finding a *prima facie* case of obviousness in this application. Nothing in the cited sections of the references appears to show or suggest "providing a set of proposed interview questions" to one of ordinary skill in the art.

"The initial burden is on the Examiner to provide some suggestion of the desirability of doing what the inventor has done." See MPEP § 706.02(J). "The Examiner should set forth in the Office Action: (A) The relevant teachings of the prior art relied upon, preferably with reference to the relevant column or page number(s) and line number(s) . . . " *Id.* The Examiner has made cited reference locations with respect to claims 1-5, however the Examiner has lumped rejections of the remaining claims together and only discussed the elements of claim 1. Thus, the Examiner has not set forth the elements of the remaining claims. It is submitted that nothing in the cited reference locations, cited by the Examiner, teaches or suggests providing any proposed interview questions to assist hiring authorities plan a structured selection interview. The Examiner has therefore made an improper simple, omnibus rejection without specificity. Furthermore, it is nonsensical to lump the rejection of claims 6, 9, 10, 12-14 and 21 together while only pointing to the limitations required of cancelled claim 1, new claim 22. See Office Action of June 29, 2005, page 3, number 6. Therefore, the Examiner's rejection of this element, which has been included into independent claims 22 and 23, is defective and should be withdrawn. As a result, new independent claims 22 and 23 are allowable.

The term "skills" has been changed to "competencies" in new claims 22 and 23. This brings the claim language in line with the Specification, which describes the defining of "competencies" best in the original Specification, page 15, lines 13-21 and page 18, line 21

through page 21, line 22, where the set of competencies are defined. Therefore, no new matter has been added.

Section (b) of new claims 22 and 23 state "ranking the set of competencies in order of importance for the specific job." The ranking of the competencies is explained in section (3) Processing the PS, page 24, line 16 to page 27, line 23. Therefore, no new matter has been added.

Claims 6, 9, 10 and 12-14 depend from independent claim 22 and are allowable as depending from an allowable claim. Therefore, it is submitted that these claims are allowable.

Conclusion

It is respectfully submitted that all matters raised in the office action have been addressed and remedied and that the application is in form for allowance.

Please consider this a one-month extension of time from September 29, 2005 to October 29, 2005 and charge Deposit Account No. 26-0084 the amount of \$60.00. No other fees or extensions of time are believed to be due in connection with this amendment; however, consider this a request for any extension inadvertently omitted, and charge any additional fees to Deposit Account No. 26-0084.

For the reasons presented above, it is believed that the application is now in proper form for allowance and that there are no remaining issues in the application. Allowance of pending claims is respectfully requested. If for any reason, the Examiner feels that the amendment does not place the application in condition for allowance, it is respectfully requested that the Examiner contact Applicant's attorney at the telephone number shown below so that the proper steps may be taken to place the application in proper form for allowance.

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Respectfully submitted,



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